

REMARKS

After entry of the subject amendment, claims 1, 2, 5, and 7 remain in the application with claim 1 in independent form.

Claims 1, 2, 5, and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by WO 97/27236 or Televantos et al. (United States Patent No. 5,767,323).

The current claims require, among other elements, that:

- (1) the compound containing at least two active hydrogen atoms include at least one polyether alcohol that has been prepared by means of multimetal cyanide catalysis; and
- (2) the reaction of the alkylene oxides onto the H-functional initiator substances is carried out in the presence of at least one metal salt of the formula $M^{(A+)}_aX^{(B-)}_b$.

Under 35 U.S.C. § 102, it is well settled that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). If even a single limitation of the rejected claim is not found in the prior art reference, then the rejection under 35 U.S.C. § 102 of the claim is improper and must be withdrawn.

The Examiner is well aware that the two § 102 references relied upon, WO 97/27236 and Televantos et al., do not disclose any metal salt that meets the definition of the formula $M^{(A+)}_aX^{(B-)}_b$, let alone any reaction that is carried out in the presence of such a metal salt. Instead, these references merely disclose base catalysis of oxyalkylation of monomeric initiators with conventional base catalysts such as NaOH and KOH. The Examiner is also well aware that these two § 102 references do not disclose, teach, or otherwise suggest neutralization of their conventional base catalysts.¹ For this reason, the Examiner relies, in error, on inherency to establish his § 102(b) rejection.

Merely because the process of neutralizing conventional base catalysts was "known at the time of invention" does not arise to an appropriate inherency rejection that anticipates a claim requiring that a specific reaction is carried out in the present of a specific metal salt ($M^{(A+)}_aX^{(B-)}_b$). For instance, it is just as likely that, the conventional base catalysts disclosed

¹ WO 97/27236 does not mention neutralization at all and Televantos et al. only mentions neutralization in Column 2, Line 42. However, when mentioning neutralization, Televantos et al. only discloses neutralization in the context of *removing* catalyst residues such that there would be no metal salt present whatsoever.

in WO 97/27236 and Televantos et al. would be removed such that there would be no catalyst to neutralize (just as Televantos et al. recognizes) Alternatively, it is just as likely that, if the conventional base catalysts disclosed in WO 97/27236 and Televantos et al. were neutralized, then the resulting metal salts would be removed and, therefore, would not remain during the reaction of the alkylene oxides onto the H-functional initiator substances as required by the claims of the present invention. Removal of conventional base catalysts and also of metal salts was also "known at the time of invention".

To support an anticipation rejection based on inherency, the Examiner must establish that the inherent feature *necessarily* flows from the teachings of the prior art. The mere fact that the claim requirements *may* 'possibly' or 'probably' flow from the teachings of the prior art is insufficient. In re Robertson, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). Relative to the present application, inherency requires that any metal salt (resulting from the neutralization of a conventional base catalyst) would inevitably and/or invariably remain. This is simply not the case and the Examiner has, therefore, not met his burden in relying on inherency.

Thus, the Examiner is, at best, left with a potential rejection under 35 U.S.C. § 103 presumably relying on WO 97/27236 or Televantos et al. in combination with Parsons et al. (United States Patent No. 5,962,749) and/or Christen et al. (United States Patent No. 4,521,548). However, it is apparent from their disclosures that Parsons et al. and Christen et al. do not disclose, teach, or suggest use of a polyether alcohol that has been prepared by means of multimetal cyanide catalysis (see independent claim 1 and No. (1) above). Therefore, it is also apparent that there is no motivation to combine either Parsons et al. or Christen et al. with WO 97/27236 or Televantos et al. as required to establish an appropriate rejection under § 103.

In view of the remarks set forth above, it is respectfully submitted that claim 1 is distinguishable over the prior art of record and is, therefore, allowable. Furthermore, the remaining claims, specifically claims 2, 5, and 7, depend directly from independent claim 1 such that these claims are also allowable.



It is respectfully submitted that the application is now presented in condition for allowance, which allowance is respectfully solicited. The Commissioner is authorized to charge our deposit account no. 08-2789 for any additional fees or credit the account for any overpayment.

Respectfully submitted,

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June 16, 2004

Date

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CERTIFICATE OF MAILING

I hereby certify that this Amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to the **MAILSTOP AMENDMENT - FEE, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, on June 16, 2004.**

Brenda J. Hughes

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